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09/783,726	02/14/2001	Mihal Lazaridis	555255012190	7167

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EXAMINER
EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application N . 09/783,726	Applicant(s) LAZARIDIS ET AL.
	Examin r Bradley Edelman	Art Unit 2153

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *05 February 2003* .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *45-55,57,60 and 62-69* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *45-55,57,60 and 62-69* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *14 February 2001* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,9-12,21
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This action is in response to Applicant's pre-amendment filed on August 22,

2002. Claims 45-55, 57, 60, and 62-69 are presented for further examination.

Drawings

1.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show

every feature of the invention specified in the claims. Therefore, the steps claimed must

be shown or the feature(s) canceled from the claim(s). No new matter should be

entered.

A proposed drawing correction or corrected drawings are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings

will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.   Claims 49 and 60 are rejected under 35 U.S.C. 112, first paragraph, as

containing subject matter which was not described in the specification in such a way as

to reasonably convey to one skilled in the relevant art that the inventor(s), at the time

the application was filed, had possession of the claimed invention.

In considering claim 60, as amended, the claim includes the steps of *replicating*

only a first portion of a message, transmitting only the replicated portion, and then

transmitting a command from the wireless device to replicate and transmit a second

portion of the message, and in response, replicating and transmitting a second portion.

The specification as originally filed does not disclose this function. It only discusses

sending a command from the mobile device to *transmit* an additional portion of the

message to the mobile device. However, the specification as originally filed does not

describe that the command can control which messages are both replicated *and*

transmitted. Thus, the amended claim language constitutes new matter.

Claim 49 also contains a similar step of *replicating* an attachment based on

whether it is a certain type. The specification as originally filed does not discuss steps

for replicating attachments, but only discusses steps for redirecting the attachments.

Thus, the amended claim language constitutes new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 45-48, 52, 62, 64, and 66-68 are rejected under 35 U.S.C. 103(a) as

being unpatentable over AirMobile (Software for Lotus cc:Mail Wireless, Communication

Client Guide, Motorola, 1995), in view of Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston").

In considering claim 45, AirMobile discloses a method for forwarding electronic messages from a messaging server to a plurality of wireless mobile devices, comprising the steps of:

Receiving the electronic messages at a messaging server ("communication server") and storing the electronic messages in a message store having a plurality of mailboxes, wherein each of the plurality of wireless mobile devices is associated with one of the plurality of mailboxes (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID); and

Without receiving requests to download the received electronic messages from the message store to the plurality of wireless mobile devices, continuously pushing the received electronic messages from the mailboxes associated with each of the wireless mobile devices to the wireless mobile devices (p. 30, ¶ 5; p. 31, ¶ 1; "server push," "enables messages to be immediately downloaded when they are received"), wherein the continuously pushing step includes the steps of:

A.   monitoring the plurality of mailboxes using a software program that interfaces with the message store and detects the received messages in the mailboxes associated with each of the wireless mobile devices (p. 30, ¶ 2, wherein the "program" is inherent since messages are stored and forwarded from the LAN-based inbox to the cc:Mail Mobile Inbox);

C & D. transmitting the electronic messages to a gateway computer system, and

at the gateway, routing the electronic messages to the wireless network (Fig. 9,

"wireless network adapter"); and

E.   transmitting the electronic messages from the wireless network to the

plurality of wireless mobile devices, and storing the messages in a memory store within

each wireless mobile device (p. 39, ¶ 1, wherein the storage is inherent).

However, AirMobile does not explicitly state that the messages are stored on the

LAN server and *replicated* before being forwarded to the wireless mail system.

Nonetheless, most LAN-based mail servers store messages in addition to forwarding

the messages to a client, as evidenced by Eggleston. In a similar art, Eggleston

teaches a system for forwarding messages from a LAN-based host through a wireless

host to a mobile client device, wherein the LAN-based host stores messages, thereby

maintaining a replica of the messages, before forwarding them to the client (col. 4, lines

44-51; col. 12, lines 32-39, wherein the messages are copied and maintained at a host

system, although they are not replicated an additional time at the "communication

server"). Thus, given the teaching of Eggleston, a person having ordinary skill in the art

would have readily recognized the desirability and advantages of replicating the

messages at the host server taught by AirMobile, to preserve received messages in

case the client memory fails. Therefore, it would have been obvious to include the mail

replication feature taught by Eggleston in the mail forwarding system taught by

AirMobile.

In considering claim 46, although neither AirMobile nor Eggleston disclose compressing the messages sent over the network, Examiner takes official notice that compression of network messages is well known. Thus, it would have been obvious to a person having ordinary skill in the art to compress the messages prior to transmission to the gateway, and to decompress the messages at the mobile device, in order to increase available bandwidth of the network.

In considering claim 47, AirMobile further discloses storing a plurality of user profiles for each of the wireless mobile devices for use by the software program, the profiles including a filter list for blocking certain electronic messages from being replicated and transmitted to the wireless mobile device (p. 10, "User Profile Database," "Filtering").

In considering claim 48, AirMobile further discloses transmitting a command message from the wireless devices to the server software program, wherein the command message adds an electronic message sender to the filter list so that messages from the sender are blocked from being forwarded to the wireless device (p. 10, ¶ 6; p. 11, ¶ 1; see also, pp. 40-41).

In considering claim 52, AirMobile further discloses a plurality of desktop computer systems in communication with the messaging server (Fig. 1-1, "cc:Mail Client"), and further teaches controlling the operation and configuration of the software

program using one of the desktop systems (the "cc:Mail Client" will be able to control

the operation of the mail box).

In considering claim 62, AirMobile further discloses transmitting a plurality of

triggering commands to the software program, each command being associated with

one of the plurality of wireless mobile devices and initiating the software program to

continuously push the received electronic messages from the mailbox associated with

the wireless mobile device to the wireless mobile device (p. 32, "Launching Motorola,"

wherein the continuous pushing for each mobile device is activated when the cc:Mail

Mobile is launched at the device).

In considering claim 64, AirMobile further discloses that the triggering commands

are generated at the wireless devices (p. 11, ¶ 1).

In considering claim 66, AirMobile further discloses providing a software interface

between the software program and the message store that enables the software

program to detect when received messages are present in the message store (inherent

in the system for forwarding messages from the message store to the mobile device as

soon as the messages are received).

In considering claim 67, although AirMobile does not explicitly disclose the use of

MAPI, Examiner takes official notice that using a MAPI to detect messages in an e-mail

mailbox is well known. Applicant's specification further supports this assertion, on page 13, lines 17-18, where it is admitted that Microsoft has developed its own MAPI for use in an e-mail host system. Thus, it would have been obvious to a person having ordinary skill in the art to associate MAPI with the messaging server taught by AirMobile, to make the system usable with a standard e-mail program such as the Microsoft Exchange e-mail program.

In considering claim 68, AirMobile further discloses generating electronic messages at a plurality of message generating computers, wherein the electronic messages are addressed for delivery to the plurality of mailboxes, and transmitting the messages to the messaging server (p. 39, ¶ 1, wherein messages received at the server are necessarily addressed to the user's e-mail account and are generated at sender computers).

4.   Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and Eggleston, in view of MobileVision (Mobile Vision User Manual, CE Software, Inc., 1995).

In considering claim 49, AirMobile discloses allowing only certain attachments to be received at the mobile device, according to user selection (p. 10, ¶ 5). However, AirMobile does not explicitly disclose determining whether an attachment is of the type that can be received and displayed at a particular mobile device, and if so, then transmitting the attachment from the software program to the wireless mobile device.

Nonetheless, this feature is well known, as evidenced by MobileVision. In a similar art,

MobileVision discloses an e-mail system for forwarding messages from a wired server

to a wireless computing device, wherein the system determines whether an attachment

is of the type that can be received and displayed at a particular mobile device, and if so,

then transmits the attachment from the software program to the wireless mobile device

(MV, p. 4-32 - "Enclosure" rules). A person having ordinary skill in the art would have

readily recognized the desirability and advantages of including such attachment

processing steps in the system taught by AirMobile and Eggleston, so that important

attachments that could be processed at the mobile device would be sent immediately,

while attachments that could not be processed by the device are maintained at the

server, thereby preserving network bandwidth. Thus it would have been obvious to

include this attachment feature in the system taught by AirMobile and Eggleston.

5.   Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable

over AirMobile, in view of Eggleston, and further in view of Ross Jr. (U.S. Patent No.

5,812,671, hereinafter "Ross").

In considering claim 50, the system taught by AirMobile and Eggleston fails to

explicitly disclose the use of encryption keys for sending the messages. Nonetheless,

storing an encryption key at a server for each of a plurality of destination devices, and

using the key to encrypt detected messages before forwarding them to a destination

device is well known, as evidenced by Ross (col. 3, lines 8-23). Given the teaching of

Ross, a person having ordinary skill in the art would have readily recognized the

desirability and advantages of encrypting the messages sent in the system taught by

AirMobile and Eggleston, to increase the security of the system. Therefore, it would

have been obvious to include the encryption steps disclosed by Ross in the system

taught by AirMobile and Eggleston.

In considering claim 51, AirMobile further discloses generating electronic

messages at the mobile device, sending them through the gateway to the server, and

transmitting the messages from the mailboxes to message recipients, wherein the

messages are addressed using the user's e-mail address ("cc:Mail" address, p. 38,

"Sending/Transmitting e-mail messages"). Although the system taught by AirMobile

does not disclose storing the reply messages at the server, Examiner takes official

notice that storing, at the e-mail server, replies and other messages generated at a

personal computing device is well known in the art. E-mail programs such as Microsoft

Exchange, Yahoo Mail, and others, include a function for storing sent messages at the

e-mail server. Therefore, it would have been obvious to a person having ordinary skill in

the art to store the messages at the server in case a user wanted to review the

previously sent messages.

In addition, it would have been obvious to a person having ordinary skill in the art

to include the reverse encryption steps as the steps taught by Ross, to allow secure

message transmission in both ways across the network, thus increasing security of the

system.

6.   Claims 53 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable

over AirMobile in view of Eggleston, and further in view of Dunker et al. (CE Software

Announces MobileVision, CE Software, Inc., 1995, hereinafter "Dunker").

In considering claim 53, AirMobile fails to explicitly disclose that the desktop

system can specifically control the monitoring step, the replicating step, and the

transmitted step. Nonetheless, enabling a desktop computer to control which messages

received at a server are forwarded to a mobile device is well known, as evidenced by

Dunker. In a similar art, Dunker discloses a system for integrating a LAN-based mail

system with a wireless pager, wherein message filtering and forwarding can be

controlled from both the wireless device and desktop computers on the LAN (p. 1, ¶ 5,

"MobileVision rules can be modified either at the office or from the road"). Given the

teaching of Dunker, a person having ordinary skill in the art would have readily

recognized the desirability and advantages of allowing a user at a desktop to control the

forwarding steps, to save battery power at the mobile device when a user is present at

home or at the office. Therefore, it would have been obvious to allow a user to control

the forwarding steps disclosed by AirMobile from a desktop, as taught by Dunker.

Claim 63 contains a similar limitation as claim 53, stating that the triggering

commands are generated at desktop computer systems coupled to the software

program via a LAN. Claim 63 is thus rejected for the same reasons as claim 53.

7.   Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over

AirMobile and Eggleston, in view of Dunker, and further in view of Microsoft Outlook 97

(Padwick et al., Que Corporation, 1997, hereinafter "Padwick").

In considering claim 57, although the combined teaching of AirMobile, Eggleston,

and Dunker discloses substantial features of the claimed invention, it fails to disclose

the use of calendar information in the electronic messaging system. Nonetheless,

Dunker discloses the use of Microsoft Mail, which had subsequently evolved into

Microsoft Outlook, which includes messaging functions for calendar information, as

evidenced by Padwick. Padwick discloses the Microsoft Outlook 97 system, which

stores calendar data for a user at a message store associated with the user, detects

changes in calendar data at the message store (i.e. meeting requests), and then

addresses and transmits the changes to the user computer (pp. 360-363). Given the

teaching of Padwick, a person having ordinary skill in the art would have readily

recognized the desirability and advantages of replacing the Microsoft Mail system

taught by Dunker with the Microsoft Outlook 97 system taught by Padwick, thereby

including storage and transmission of meeting requests, to increase the functionality of

the mobile device (see also, Isomursu et al., U.S. Patent No. 6,400,958, col. 8; Deo et

al., U.S. Patent No. 6,356,956, cols. 3-4; both describing pager devices that can receive

calendar messages from a host computer). Therefore, it would have been obvious to

use the Microsoft Outlook 97 system taught by Padwick, in the combined message

forwarding system taught by AirMobile, Eggleston, and Dunker.

8.   Claims 54, 55, and 69 are rejected under 35 U.S.C. 103(a) as being

unpatentable over AirMobile, in view of Eggleston, and further in view of Gleason (U.S.

Patent No. 5,966,663).

In considering claim 54, although the system taught by AirMobile and Eggleston

discloses substantial features of the claimed invention, it fails to explicitly disclose that

the mobile device is a pager. Nonetheless, using pagers to receive wireless e-mail is

well known, as evidenced by Gleason (col. 1, lines 15-35; col. 10, lines 31-55; Fig. 1,

describing a paging system employing a PDA to receive e-mail). Therefore, given the

teaching of Gleason, a person having ordinary skill in the art would have readily

recognized the desirability and advantages of using a pager to receive the forwarded

messages taught by AirMobile and Eggleston, so that users can use one small device to

receive their e-mail while on the road. Therefore, it would have been obvious to receive

the messages taught by AirMobile and Eggleston using a pager, as taught by Gleason.

In considering claim 55, Gleason further teaches that the pager may receive

voice messages (col. 1, lines 33-35, "voice or video data"). It would have been obvious

to a person having ordinary skill in the art to include this feature in the combined

teaching of AirMobile, Eggleston, and Gleason, so that blind users could more easily

interpret messages sent to their mobile devices.

In considering claim 69, AirMobile further discloses that the messages to be

redirected use a wireless network address associated with one of the plurality of

wireless mobile devices (p. 10, "User Profile Database," p. 15, "wireless radio

addresses"). Gleason further discloses that the forwarding system can use Internet

addressing before being forwarded to the wireless system (col. 11, lines 45-63; col. 12,

lines 8-21; Fig. 1). Thus, given the teaching of Gleason, a person having ordinary skill

in the art would have readily recognized the desirability and advantages of using the

system taught by AirMobile and Eggleston on mail systems connected to the Internet,

so that Internet users worldwide could benefit from the messaging system taught by

AirMobile and Eggleston. Therefore, it would have been obvious to address the

redirected messages taught by taught by AirMobile and Eggleston with an Internet

address.

9.   Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over

AirMobile and Eggleston, further in view of either Adler et al. (U.S. Patent No. 6,157,630,

hereinafter "Adler") or alternatively Zerber (U.S. Patent No. 5,951,636).

In considering claim 60, although the combined teaching of AirMobile and

Eggleston discloses substantial features of the claimed invention, it fails to disclose the

claimed steps of retrieving different replicated portions of the messages at different

times and according to a user selection. Nonetheless, retrieving a first portion of a

message at the destination, transmitting a request from the destination to retrieve a

second portion of the message, and then sending that second portion from the

messaging server is well known in the art, as evidenced by both Zerber and Adler. In a

similar art, Zerber discloses downloading a first portion of a message ("header") at a

client, then transmitting a command to a server to download additional content of the

message, and finally transmitting that second portion to the client in response (claim 1,

steps (c), (g), and (h)). Similarly, Adler discloses a system for forwarding messages to

a wireless device, wherein the user can select for a first portion of a message to be

received first, and can then subsequently request additional portions of the messages to

be sent (col. 5, lines 3-9). Thus, given the teaching of either Zerber or Adler, a person

having ordinary skill in the art would have readily recognized the desirability and

advantages of using the message retrieval function taught by Zerber or Adler in the

system taught by AirMobile and Eggleston, to minimize transfer time, and to consume

minimal resources at the wireless device (see Zerber, col. 2, lines 24-30). Therefore, it

would have been obvious to use the message retrieval system taught by either Zerber

or Adler in the system taught by AirMobile and Eggleston.

10.   Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over

AirMobile and Eggleston, in view of Applicant's admission of prior art.

        In considering claim 65, claim 65 includes the limitation that the wireless mobile

devices transmit a confirmation signal to the software program to indicate that the

messages have been received at the devices. This feature is well known, as evidenced

by Applicant's admission of the prior art ("Background of the Invention," p. 1, line 25 – p.

2, line 2 of the specification, "Wireless mobile data communications devices, especially

those that can return a confirmation signal to the host that the pushed data has been

received, are especially well suited for this type of push paradigm."). Thus, it would

have been obvious to a person having ordinary skill in the art to send a confirmation

message to the server in the system taught by AirMobile and Eggleston, so that the

server can re-send any messages that fail to reach their destination.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
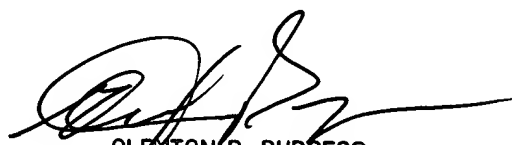
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all After Final papers: (703) 746-7238.

For all other correspondences: (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

BE
April 9, 2003